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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: July 11, 2006

Opposition No. 91161373

AMERICAN ITALIAN PASTA COMPANY

v.

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI[1]

Before Hairston, Grendel, and Zervas, Administrative Trademark Judges.

By the Board:

On July 21, 2004, American Italian Pasta Company filed a notice of opposition against application Serial No. 78136703[2] on the ground that applicant's mark BARILLA – AMERICA'S FAVORITE PASTA (AMERICA'S FAVORITE PASTA disclaimed), when used on applicant's "pasta, pasta products, namely meals consisting primarily of pasta, macaroni salad,

[1] This order corrects the record to reflect that applicant is Barilla G. E. R. Fratelli - Societa per Azioni, and not Barilla Alimentare S.p.A. Notwithstanding the name change recorded with the USPTO Assignment Services Branch (Reel 2852, Frame 0797), the Board instituted this proceeding in applicant's former name. The Board regrets the error.

pasta salad, sauces for pasta," so resembles opposer's previously used mark AMERICA'S FAVORITE PASTA for the same or similar goods, the subject of opposer's pending application Serial Nos. 76497190[3] (AMERICA'S FAVORITE PASTA) and 76497489[4] (AMERICA'S FAVORITE PASTA and design), as to be likely to cause confusion. On September 14, 2005, the Board granted opposer's motion to amend the notice of opposition to add the claim that applicant, at the time of filing its application, did not have a bona fide intention to use the mark in commerce. On October 18, 2005, applicant filed an answer which denied the salient allegations of the amended notice of opposition, and pleaded the following affirmative defenses:

> Opposer has conceded that AMERICA'S FAVORITE PASTA is not inherently distinctive in connection with its pasta products.
>
> Opposer's alleged AMERICA'S FAVORITE PASTA mark lacks acquired distinctiveness, and the opposition thereby fails to state a claim upon which relief can be granted.
>
> The opposition is barred by the equitable doctrines of laches and/or estoppel.

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[2] Application Serial No. 78136703 was filed June 18, 2002 based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act.

[3] Application Serial No. 76497190, filed March 14, 2003, alleges use in commerce since May 2002, seeks registration pursuant to Trademark Act Section 2(f) as to AMERICA'S FAVORITE PASTA for "pasta," and disclaims PASTA.

[4] Application Serial No. 76497489, filed March 14, 2003, alleges use in commerce since September 1997, seeks registration pursuant to Trademark Act Section 2(f) as to AMERICA'S FAVORITE PASTA and design for "pasta," and disclaims PASTA.

> The alleged trademark AMERICA'S FAVORITE PASTA is misdescriptive of Opposer's goods, which lack the requisite market share to support such claim.

On January 30, 2006, applicant filed a motion for summary judgment or, in the alternative, to reopen discovery. The motion has been fully briefed.[5]

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Applicant's motion for summary judgment alleges that opposer's pleaded mark AMERICA'S FAVORITE PASTA is merely descriptive of pasta, that the mark has not acquired distinctiveness as an indicator of source, and that the mark is incapable of acquiring distinctiveness. While applicant did not plead the affirmative defense that AMERICA'S FAVORITE PASTA is incapable of acquiring distinctiveness as a trademark, opposer did not object to the motion on that basis and the parties, in briefing the summary judgment motion, have treated the issue of whether AMERICA'S FAVORITE PASTA is incapable of functioning as a trademark on its merits. Indeed, opposer, in the preface to its brief in opposition to the summary judgment motion, states that the "single issue" before the Board is whether in view of the evidence of trademark use by opposer, applicant is entitled

[5] Opposer's March 20, 2006 motion to substitute exhibits to supply two declarations missing from the exhibits submitted with its opposition to applicant's motion for summary judgment is granted.

to summary judgment on the basis that the mark is incapable of functioning as a trademark and that this issue "envelopes all subissues" related to the motion for summary judgment. Accordingly, the Board deems applicant's answer to have been amended, by agreement of the parties, to allege that opposer's mark AMERICA'S FAVORITE PASTA is incapable of acquiring distinctiveness as a trademark. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994), *aff'd* (unpub'd), 108 F.3d 1392 (Fed. Cir. 1997).

In an effort to determine the summary judgment motion as expeditiously as possible, an exhaustive review of the record will not be provided. It is presumed that the parties are familiar with the record. The Board has carefully reviewed the motion for summary judgment, the response, the reply brief, and all accompanying evidence.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. Pro. 56(c); and *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). In assessing each motion, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. In considering the propriety of summary judgment, the Board may not resolve issues of material fact; it may only ascertain

whether such issues are present. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

While opposer's applications are not the subject of this proceeding, opposer has pleaded ownership of the applications. A review of the applications reveals that opposer has sought registration under Section 2(f), and this constitutes an admission by opposer that the phrase AMERICA'S FAVORITE PASTA is merely descriptive of the applied-for goods, pasta. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Moreover, opposer's opposition to applicant's motion for summary judgment does not contest that the phrase AMERICA'S FAVORITE PASTA is merely descriptive as applied to pasta. Accordingly, because there is no genuine issue of material fact with respect to mere descriptiveness, applicant's motion for summary judgment is granted as to that issue.

We now turn to applicant's two remaining contentions in its summary judgment motion, i.e., that the mark has not acquired distinctiveness as an indicator of source, and that the mark is incapable of acquiring distinctiveness. Upon

careful consideration of the arguments and evidence presented by the parties, and appropriate resolution of all reasonable inferences, we find that there are genuine issues of material fact as to, at a minimum, whether the term AMERICA'S FAVORITE PASTA is incapable of indicating the source of opposer's pasta and distinguishing it from similar products made by others, and whether the term AMERICA'S FAVORITE PASTA is registrable under the provisions of Section 2(f) because it has acquired distinctiveness through use and promotion since 1997 in connection with opposer's pasta. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999)(THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978)(AMERICA'S FAVORITE POPCORN found to be merely laudatory epithet describing claimed popularity of applicant's goods, unregistrable in the absence of compelling proof of acquired secondary meaning).

Accordingly, with respect to the issues of whether the term AMERICA'S FAVORITE PASTA is incapable of indicating the source of pasta, and whether the term AMERICA'S FAVORITE

PASTA has acquired distinctiveness, applicant's motion for summary judgment is denied.[6]

APPLICANT'S MOTIONS TO EXTEND AND TO REOPEN DISCOVERY

Before turning to applicant's motion to reopen discovery as an alternative to its motion for summary judgment, we address applicant's motion to extend discovery which was pending at the time applicant filed its motion for summary judgment.[7] Specifically, on November 1, 2005, applicant moved to extend discovery for two days on the grounds that the Board's September 14, 2005 order granting opposer's motion to amend the notice of opposition and resetting discovery to close November 1, 2005 had not been received for almost two weeks after it issued, and that on October 18, 2005, counsel for applicant had been involved in a car accident that impaired counsel's ability to work. In its opposition to the requested extension opposer contends, in view of the many prior extensions to which opposer

[6] The parties should note that evidence submitted in connection with a motion for summary judgment is of record only for consideration of the motion. Any evidence to be considered at final hearing must be properly introduced in evidence during the trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

[7] After applicant filed its motion for summary judgment, applicant filed a stipulated motion to extend trial dates. Applicant's request for reconsideration of the Board's January 4, 2006 order approving the parties' stipulated motion notes that the Board's order should be corrected to reflect that the stipulated motion extended only to trial periods, and not discovery. The request for reconsideration is granted.

consented, that the instant request is excessive; that on the last day of discovery the injured attorney was able to serve a third request for documents, a fourth request for admissions, and a third set of interrogatories; that applicant did not seek opposer's consent before filing the motion to extend; that on November 3, 2005 applicant served opposer with eight additional interrogatories, 44 requests for admission, and 11 requests for documents; that the shortness of the requested two day extension combined with the failure to notify opposer that the two day extension was sought results in a unilateral extension for applicant; and that under these circumstances applicant has failed to show good cause for its extension.

We find that the time lost by applicant due to the delay in receiving the Board's order and due to counsel's injury constitutes good cause for the extension. However, the Board also agrees that applicant's failure to notify opposer that it was seeking a two day extension *prior* to the expiration of the two day extension results in a unilateral extension for applicant. Opposer's argument that opposer should also receive the benefit of an extended discovery period is well taken. Applicant's motion to extend discovery is granted to the extent set forth at the end of this order.

We now turn to applicant's motion to reopen discovery as an alternative to its motion for summary judgment. Applicant argues in the alternative that discovery should be reopened to allow applicant to take discovery, including deposition testimony and a subpoena duces tecum, regarding the recently discovered consumer study which opposer forwarded to applicant on December 1, 2005. Opposer contends in opposing the motion that applicant had the study for more than six weeks before moving to reopen, that applicant has been dilatory, that this is another attempt to delay proceedings, and that, if reopened, discovery also should be available to opposer.

Inasmuch as it was plainly impossible for applicant to take discovery on a consumer study which was not produced until after discovery closed, we find that applicant's neglect in taking discovery on the consumer study is excusable and that it is entitled to take discovery relating to the consumer study. Applicant's motion to reopen discovery is granted to the extent set forth at the end of this order.[8]

[8] Opposer's March 2004 "Brand Health Tracking Study" was marked confidential and will not be described in detail. However, the Board notes that this study, which was submitted by both parties in connection with the motion for summary judgment, does not appear to be probative as to any issue in this proceeding. The study does not involve opposer's mark AMERICA'S FAVORITE PASTA. Rather, the study is directed to understanding how consumers perceive six of the different brands opposer owns (one of which is the Mueller's brand with which AMERICA'S FAVORITE PASTA is used) compared to competitors in the dry pasta

In sum, applicant's motion for summary judgment is granted in part as to the affirmative defense that the term AMERICA'S FAVORITE PASTA is merely descriptive, and is denied in part as to the affirmative defenses that the term AMERICA'S FAVORITE PASTA is incapable of acquiring distinctiveness as a trademark and has not acquired distinctiveness as a trademark. Applicant's motion to extend discovery for two days is granted. Opposer is ordered to respond to the discovery requests served November 3, 2005 within thirty days from the mailing date of this order. Applicant's motion to reopen discovery for the limited purpose of seeking discovery regarding the consumer study is also granted. However, to avoid the unilateral extension to applicant of an unrestricted discovery period, we will reopen discovery without restriction to subject matter. Accordingly, discovery is reopened for thirty days, for both parties, without restriction to subject matter.

Proceedings are resumed. Discovery and trial dates are reset as follows:

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market, and what features drive brand choice by consumers. The study does not address consumer perception of opposer's use of its AMERICA'S FAVORITE PASTA marks.

DISCOVERY PERIOD TO CLOSE:	**August 15, 2006**
Thirty-day testimony period for party in position of plaintiff to close:	**November 13, 2006**
Thirty-day testimony period for party in position of defendant to close:	**January 12, 2007**
Fifteen-day rebuttal testimony period to close:	**February 26, 2007**

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